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DEC 06 2005

In re Application of :
Ke-Li Wu et al. :
Application No. 10/620,300 :
Filed: July 14, 2003 :
Attorney Docket No. CUH-007.01 :

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition filed November 21, 2005, under 37 CFR 1.137(a)¹ and in the alternative, under 37 CFR 1.137(b)² to revive the above-identified application. The petition also seeks a waiver of the petition fee under 37 CFR 1.183.

The petition under 37 CFR 1.137(a) is **GRANTED**.

The petition under 37 CFR 1.137(b) is **DISMISSED** as involving moot issues.

The petition under 37 CFR 1.183 is **DISMISSED**.

This application became abandoned September 20, 2005 for failure to pay the issue

¹A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(l);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

²Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

fee by September 19, 2005, in response to the Notice of Allowance mailed June 17, 2005. The instant petition and this decision precede the mailing of a Notice of Abandonment.

Petitioner argues that a change of address was filed March 18, 2005 and that the Notice of Allowance, mailed June 17, 2005, was mailed to an incorrect address and thus not received. Petitioner explains that with a response to an office action mailed and received by the USPTO On March 21, 2005, petitioner included a revocation and power of attorney which therein included a change of address but that the change of address was not recorded with the USPTO and thus, the Notice of Allowance was not received by the new attorneys.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs; and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure or mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.⁴

A review of the file reveals that the petitioner is correct, that a change of address was in fact filed on March 18, 2005 (certificate of mail date), prior to the mailing of the Notice

³In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁴Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

of Allowance. Furthermore, the Notice mailed June 17, 2005 was returned to the USPTO as undeliverable. It is noted therefore that an error on the part of the USPTO caused the office action mailed to not be received by the petitioner. Thus, petitioner's delay in paying the issue fee was unavoidable under the standard set out at 37 CFR 1.137(a).

In view thereof, it will not be necessary to treat the petition under the unintentional standard. However, with respect to the request to waive the petition fee, a petition fee is required for treatment of a petition to revive under either 37 CFR 1.137(a) or (b) and thus since relief under 37 CFR 1.137(a) was petitioned, cannot be waived.

The revocation, power of attorney and change of address have been corrected and this matter is being referred to the Publishing Division to be processed into a Patent.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.


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